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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,969	08/10/2005	Ruediger Kreuter	02968.268USWO	3601

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MINNEAPOLIS, MN 55402-0903

EXAMINER
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HIGGINS, GERARD T

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/517,969

**Applicant(s)**

KREUTER, RUEDIGER

**Examiner**

GERARD T. HIGGINS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-21, 23-25, 27-30, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-21, 23-25, 27-30, 34, and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/2008 has been entered.

### ***Response to Amendment***

2. The amendment filed 11/24/2008 has been entered. Currently claims 12-21, 23-25, 27-30, 34, and 35 are pending, claims 1-11, 22, 26, and 31-33 are cancelled, and claims 34 and 35 are new.

Please note that applicants' amendment should have reflected changes from the previous **entered** amendment filed on 01/30/2008. Applicants' changes are shown with respect to the claims filed on 11/05/2008, which was after a final rejection and not entered in the case. In the interest of expediting prosecution the Examiner will treat the present claims, while still recognizing that claims 34 and 35 are new and other changes have not been properly identified in other claims.

Also please note that applicants refer to the original specification when citing support for claims 34 and 35 in their Remarks; however, they subsequently filed a

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substitute specification on 01/30/2008. This substitute specification does not have a page 6.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25, 34, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 25, applicants are not supported for saying "the identity card comprises a plastic card."

With regard to claims 34 and 35, while the Examiner recognizes the disclosure of "a layer-wise structure of the protective coatings" on page 5, line 26, this does not provide support for the "***plurality*** of layers of the protective coating."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 13, 16-21, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. (5,879,775) in view of Becker et al. (4,765,656).

With regard to claims 12 and 21, Walter et al. disclose protective coatings for identity documents such as security cards, credits cards, personal ID cards, debit cards, etc. (col. 3, line 66 to col. 4, line 24). The card includes a substrate of plastic media such as a plastic card coated with a protective coating, which has been deposited out of the gas phase (col. 2, lines 26-43). The protective layer has not been secured using an adhesive layer, and can be in the range of a "hundred to several thousand angstroms thick" (col. 2, lines 1-5); however, they do not disclose that there is information on the substrate that adheres better to the protective coating than with respect to the substrate, and they fail to disclose that the protective coating can be penetrated by laser light to personalize the substrate without producing an optical variation in the protective coating.

Becker et al. disclose at col. 6, lines 14-25 that it is known to burn, by using a laser, user-related data to an inner volume area through a transparent cover film. They also disclose in the same passage that these identity documents can have "general information...printed onto one of the card layers using printing techniques."

Since Walter et al. and Becker et al. are both drawn to identity documents, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of writing user-related data to an inner volume of a

protective layer coated identity document of Becker et al. with the protective coated identity document of Walter et al.; furthermore, it would have been obvious to print general information on the card, such as the name of the institution, because that would be cheaper than laser writing all of the information on the card.

With regard to the limitation that the "adhesion of the information with respect to the protective coating is greater than with respect to the substrate," given the fact that the Examiner has rendered obvious all of the structural limitations and materials of applicants' claim 12, the Examiner deems that the article of Walter et al. in view of Becker et al. would intrinsically meet the limitation that the "adhesion of the information with respect to the protective coating is greater than with respect to the substrate."

With regard to claim 13, Walter et al. disclose that the protective coating may comprise silicon oxide (col.2, line 20 and col. 3, lines 32-39).

With regard to claims 16-19, since the materials of Walter et al. are the same as what applicants intend, including metal oxides and diamond-like carbon deposited out of the gas or plasma phase, the claimed properties of the protective layer seen in claims 16-19 would be inherent. Walter et al. also disclose at col. 4, lines 11-24 the numerous benefits of these protective layers, including their resistance to chemical attack and scratching.

With regard to claim 20, Walter et al. disclose at col. 1, lines 26-30 common materials for the plastic card substrate, including polycarbonate.

With regard to claim 21, since the materials of the protective layer of Walter et al. are the same as those claimed by applicant, the Examiner deems that the protective coating would intrinsically possess the ability to be penetrated by laser light.

With regard to claim 34, the Examiner deems this to be a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). The duplication of a protective layer would not produce a new and unexpected result because multiple protective layers would serve to provide enhanced protection.

7. Claims 23-25, 27, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. (5,879,775) in view of Ugon (4,591,945).

With regard to claims 23-25, Walter et al. disclose protective coatings for identity documents such as security cards, credits cards, personal ID cards, debit cards, etc. (col. 3, line 66 to col. 4, line 24). The card includes a substrate of plastic media such as a plastic card coated with a protective coating, which has been deposited out of the gas phase (col. 2, lines 26-43). The protective layer has not been secured using an adhesive layer, and can be in the range of a "hundred to several thousand angstroms thick" (col. 2, lines 1-5); however, they fail to disclose that the protective layer is covering an electronic chip.

Ugon discloses that electronic chips are known to be recessed into credit cards (col. 1, lines 11-18 and col. 3, lines 8-19). The auxiliary insulating carrier element 4

reads on applicants' protective layer in that it protects the electronic chip and the substrate carrier element 2.

Since Walter et al. and Ugon are both drawn to identity cards such as credit cards; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the electronic chip into the credit card assembly of Walter et al. The results from this combination would have been predictable; further, each of the elements would have performed the same in combination as they had separately. The motivation for using these electronic chips is to produce smart cards that allow users to pay in a store more rapidly; hence reducing wait times.

With regard to claim 27, Walter et al. disclose a carbon material includes diamond-like carbon, which is disclosed at col. 3, lines 49-59.

With regard to claim 28, Walter et al. disclose at col. 4, lines 8-10 that the card may be provided with optical features, which the Examiner deems to be individualization, which are then overcoated with the inventive protective layer.

With regard to claim 35, the Examiner deems this to be a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). The duplication of a protective layer would not produce a new and unexpected result because multiple protective layers would serve to provide enhanced protection.



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8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. (6,245,382) in view of Becker et al. (4,765,656), as applied to claim 12, and further in view of Ohnishi et al. (5,635,572).

Walter et al. in view of Becker et al. set forth all the limitations of applicant's claims 12 as seen in section 6 above; however, Walter et al. fail to disclose a protective layer comprising silanes/silazanes or fluoride materials.

Ohnishi et al. disclose a topcoating composition that may comprise a silane compound (col. 6, line 55 to col. 7, line 6) or it may comprise fluoride in the form of fluoroolefins (col. 3, lines 3-17).

Since Ohnishi et al. and Walter et al. in view of Becker et al. are drawn to coatings providing chemical and abrasion resistance, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the known coating compositions of Araki et al. on the data carrying substrates of Walter et al. in view of Becker et al. The results of this would have been obvious to one of ordinary skill in the art, specifically to provide coatings having enhanced resistance to chemicals or abrasion (see e.g. col. 1, lines 11-14 of Ohnishi et al.).

9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. (6,245,382) in view of Ugon (4,591,945), as applied to claim 23, and further in view of Becker et al. (4,765,656).

With regard to claims 29 and 30, Walter et al. in view of Ugon disclose all of the limitations of applicants' claim 23 in section 7 above; however, they fail to disclose a

coating, which has an irreversibly variable refractive index, and also it fails includes one section or a plurality of different color sections that have been varied by laser radiation.

Becker et al. disclose at col. 9, line 41 to col. 10, line 51 that it is known to include a layer of a transparent material above the core layer (substrate) that also can be colored by the laser light. This transparent layer can be a part of the cover layer (col. 9, line 64 to col. 10, line 8). In the transparent layer blackened areas can be formed; further, the degree of blackening can be adjusted so that it is possible to form half-tone images (varying in color) (col.10, lines 48-51).

Since Becker et al. and Walter et al. in view of Ugon are both drawn to identify documents, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the writing method of Becker et al. in the protective coatings of Walter et al. in view of Ugon. The results of which would have been predictable to one having ordinary skill in the art. One would have been motivated to do this in order to provide an identity document that was more tamper-resistant.

### ***Response to Arguments***

10. Applicant's arguments, see Remarks, filed 11/24/2008, with respect to the rejection of claims 12-21, 23-25, and 27-30 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The previous rejection has been withdrawn; however, the Examiner notes once again that the language regarding the plurality of protective layers in claims 34 and 35 is not supported by the originally filed specification.

11. Applicant's arguments with respect to claims 12-21, 23-25, 27-30, 34, and 35 have been considered but are moot in view of the new ground(s) of rejection.

Applicants have amended claim 12 such that it reads that "the substrate is provided with information on the surface thereof and adhesion of the information with respect to the protective coating is greater than with respect to the substrate." This limitation was not previously examined, and as such the Examiner has made a new rejection using Walter et al. (6,245,382) in view of Becker et al. (4,765,656). Becker et al. teach information provided on any one of the card layers of their ID card. The Examiner deems that the device of Walter et al. in view of Becker et al. would intrinsically display the "adhesion of the information with respect to the protective coating is greater than with respect to the substrate" because the information was printed in a manner identical to that of applicants and the protective coating is made of materials identical to that of applicants.

With regard to claim 23, applicants have imported the limitations of applicants' claim 26 into independent claim 23; however, they have deleted reference to a magnetic strip. The Examiner has found the reference Ugon (4,591,945), which teaches electronic chips used in the substrate of the ID card or credit card. These "Smart Cards" are known to one having ordinary skill as taught by Ugon.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner has cited the references used in the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins  
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Art Unit 1794

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